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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/245,101	01/21/1999	MARK H. KRAML	5	4519

7590 01/05/2004

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EXAMINER

BANGACHON, WILLIAM L

ART UNIT	PAPER NUMBER
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2635

DATE MAILED: 01/05/2004

15

Please find below and/or attached an Office communication concerning this application or proceeding.

TS

Office Action Summary

Application No.

09/245,101

Applicant(s)

KRAML, MARK H.

Examiner

William Bangachon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-17,19-34,36-44 and 46-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-17,19-34,36-44 and 46-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character **"150"** has been used to designate both **"a target device"** and **"a computer-controlled target device"** {amendment, page 12, lines 1618} (i.e. not all target devices are computer controlled devices). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. This objection is maintained in this Office action because the applicant did not address it.

Response to Arguments

2. Applicant's arguments have been fully considered but they are not persuasive.

Applicant argues that the claimed **"each specific command causes said remotely located computer-controlled device to perform at least two actions"** (page 14) is described in the original specification based on the excerpt from page 7, lines 20-23. The examiner respectfully traverses applicant's argument in that, there is no indication in the excerpt that **each specific signal or command causes said remotely located computer-controlled device to perform at least two actions**. There is no indication in the excerpt for a trigger signal containing two commands causing two mechanical actions or a computer

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command causing two operations to be performed in a software-controlled component of the target device 150. Therefore, rejection to claims 1-57 under 35 U.S.C. 112, first paragraph, is maintained in this Office action.

3. In response to applicant's arguments against the references individually {page 17, 1st paragraph}, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Moughanni was relied upon to teach a pager for wireless control and Warner was relied upon to teach single commands for a multiplicity of functions for the purpose of eliminating time consuming procedures. And clearly, the content data portion of the paging message of Moughanni includes a program processed in the data processing section (20) as shown in figure 1. As can be seen in figure 1, the data processing section (20) includes a CPU (28).

4. Finally, applicant's arguments with respect to claims 7, 17, and 34 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

5. Claims 1-57 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a

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way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 1, 28 and 55 recites the functional limitation “**wherein each specific command causes said remotely located computer-controlled device to perform at least two actions**” (analogous to sending a paging message to turn on the thermostat and set the temperature to 72 degrees {amendment, page 16, lines 7-8}), is not supported in the disclosure as originally filed. This feature was introduced in paper 7. However, the original disclosure does not teach or suggest such features.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1-6, 9-11, 28-34, and 36-37 are rejected under 35 U.S.C. 103(a) as obvious over US 5,608,655 (Moughanni et al) in view of US 4,214,229 (Warner).

In claim 1, Moughanni et al teach of a system (10) for operation of a remotely located computer-controlled (20) device (50) {see whole document} comprising,

receiver means (12) for receiving at least one paging messages {col. 1, lines 48-62; col. 3, lines 42-55}, said receiver means being co-located with said remotely located computer-controlled (20) device (50) as shown in figure 1.

means for comparing content data of said at least one paging messages to a set of allowed commands (28) {col. 4, lines 42-67}; and

means for sending a specific command to said remotely located device, said specific command being determined based on a match found between said received paging message contents and one of said allowed commands (34) {col. 5, lines 1-54}.

Although Moughanni et al suggests additional function bits may be added to identify different types of commands within a command signal {Moughanni et al, col. 6, lines 14-19}, Moughanni et al does not disclose expressly **“each specific command causes said remotely located computer-controlled device to perform at least two actions”** (amendment, page 16, lines 7-9). Warner, in the same field of endeavor (remote controllers) teach of **“a remote control device adapted to operate on a single remotely transmitted standardized command signal of a specific duration having a frequency within a predetermined frequency band, to actuate one or more control functions at the receiver”** {Warner, abstract}. This is analogous to the claimed **“each specific command causes said remotely located computer-controlled device to perform at least two actions”**. Further, Warner suggests that “commands for a multiplicity of functions can be accomplished using a single command eliminate time consuming procedures” {col. 2, lines 14-17}. Clearly, this is beneficial in the system of Moughanni et al. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have a remote controlled device wherein **“each specific command causes said remotely located computer-controlled device to perform at least two actions”** in the system of Moughanni et al, as taught by Warner, because

"commands for a multiplicity of functions accomplished using a single command eliminates time consuming procedures".

And clearly, the content data portion of the paging message of Moughanni includes a program processed in the data processing section (20) as shown in figure 1. As can be seen in figure 1, the data processing section (20) includes a CPU (28)

In claim 2, the system (10) of claim 1, further comprising buffer means (24 or 30) for receiving said at least one paging message from said receiver means {col. 4, lines 33-43}.

In claims 3 and 4, said means for sending (34) further comprises command generation means (36) for constructing said specific command to be forwarded to said remotely located computer-controlled (20) device {col. 5, lines 46-54}.

In claims 5 and 6, said specific command is a trigger signal {col. 5, lines 55-col. 6, line 20}.

In claims 9 and 10, said message contents includes more than one of said allowed commands {col. 4, lines 54-67; col. 5, lines 50-53; col. 6, lines 15-18}.

Claims 28-34 and 36-37 recites a method of using the system of claims 1-6 and 9-10 and therefore rejected for the same reasons.

10. Claims 11-17, 19-27, 38-44, and 46-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,608,655 (Moughanni et al) and US 4,214,229 (Warner), and further in view of US 5,588,038 (Snyder).

In claims 11, 21 and 23, Moughanni et al does not disclose a response means for sending a response paging message/indication of the status of said remotely located device. However, these claim limitations are conventional in paging systems, as evidenced by Snyder, and would have been obvious in the system of Moughanni et al, to one of ordinary skill in the art.

Snyder, in the same field of endeavor (remote control using paging devices), teach of a response means/transceiver (202) for sending a response paging message {see whole document}. This feature is beneficial because the owner of the controlled device can be provided with the status of the controlled device for personal use or that can be relayed to law enforcement agencies {Snyder, col. 2, lines 43-50; col. 10, lines 48-67}. Furthermore, the two-way pager (202) "can be used to send signals that are responsive to sensing various conditions and that request an action by the owner" {col. 10, lines 64-67}. Obviously, this feature is implementable and beneficial in the system of Moughanni et al to one of ordinary skill in the art. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art, to have a

response means for sending a response paging message in the system of Moughanni et al, as claimed in claim 11, because the owner of the controlled device can be provided with the status of the controlled device (50) for personal use or that can be relayed to law enforcement agencies, as evidenced by Snyder.

In claim 12, the system (10) of claim 11, further comprising buffer means (24 or 30) for receiving said paging message from said receiver means {col. 4, lines 33-43}.

In claims 13 and 14, said means for sending (34) further comprises command generation means (36) for constructing said specific command to be forwarded to said remotely located device {col. 5, lines 46-54}.

In claims 15 and 16, said specific command is a trigger signal {col. 5, lines 55-col. 6, line 20}.

In claim 17, said specific command is a command string as shown in figure 4 {col. 4, lines 28-33}.

In claims 9, 10, 19 and 20, said message contents includes more than one of said allowed commands {col. 4, lines 54-67; col. 5, lines 50-53; col. 6, lines 15-18}.

In claim 22, the system of claim 21, wherein said means for creating said paging response message includes sensing means for determining the state of said remotely located device {Snyder, col. 10, lines 51-67}.

In claim 24, the system of claim 11, wherein said response paging message includes a security challenge message {Snyder, col. 6, lines 26-30}.

In claims 25 and 26, obviously, said response-paging message/status of the controlled device includes an indication of the success or failure of the execution of at least one of said specific commands to one of ordinary skill in the art. Any status response by the controlled device would clearly be an indication of success or failure of the execution of specific commands.

In claim 27, clearly, said response paging message includes data collected by or from said remotely located device since the response includes the status of the controlled device.

Claims 38-44 and 46-54 recites a method of practicing the system of claims 11-17 and 19-27 and therefore rejected for the same reasons.

Claim 55 recites the claims limitations of claims 1-27 and therefore rejected for the same reasons.

In claims 56 and 57, Moughanni et al in view of Snyder does not disclose a period of time that is a variable component of said received paging message wherein said period of time is a predetermined minimum period of time for performance of said command by said remotely located device. However, these claim limitations are a matter of design choice in the control of a remotely located device and would have been obvious in the system of Moughanni et al to one of ordinary skill in the art.

Moughanni et al teach of "remotely controlling thermostats, cars, television, and almost all household appliances which use electronic circuits for control" {col. 2, lines 49-63}. Not only do Moughanni et al teach of turning on or off an appliance, but also teach of enabling and programming a thermostat and video recorder. By way of example, Moughanni et al teach of paging the thermostat of an owner's home by dialing in a first command to turn on the heater and dialing in a second command that specifies a temperature {lines 52-56}. Obviously, the thermostat can also be turned on and off at certain period of times. And obviously, the predetermined minimum period of time for performance of said command by any of the appliance/device as claimed, depends on what appliance/device is to be controlled. Further, the thermostat of an owners home may require to be turned on for several hours or the thermostat of an owners car may be turned on for several minutes. Therefore, at the time of the invention, it would have been a matter of design choice to have a predetermined minimum

period of time for performance of said command by any of the appliance/device in the system of Moughanni et al, to one of ordinary skill in the art.

11. Claims 7, 17, and 34 are rejected under 35 U.S.C. 103(a) as obvious over US 5,608,655 (Moughanni et al) in view of US 4,214,229 (Warner), and further in view of USP 6,075,863 (Krishnan et al).

In claims 7, 17, and 34, Moughanni or Warner does not disclose expressly "the program is a Java Applet". Krishnan, in the same field of endeavor (pager communication), suggests that it is desirable to provide a method of controlling modem hardware (10) {Krishnan, col. 1, lines 55-60}, such as a pager {Krishnan, col. 2, line 41}, with Java Applets because Java Applets provide a convenient, hardware independent means for maintaining up to date communication protocols and for updating devices (10) with new features and capabilities {Krishnan, abstract}. Clearly, these features are desirable in the system of Moughanni. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have a Java Applet, as claimed, in the system of Moughanni because Java Applets provide a convenient, hardware independent means for maintaining up to date communication protocols and for updating the pager (10) of Moughanni with new features and capabilities, as evidenced by Krishnan.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Examiner Contact Information

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Bangachon whose telephone number is 703-305-2701. The examiner can normally be reached on 4/4/10.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 703-305-4704. The fax phone numbers for the organization where this application or proceeding is

assigned is 703-872-9314 for regular and After Final formal communications.

The examiner's fax number is 703-746-6071 for informal communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

William L Bangachon
Examiner
Art Unit 2635

December 29, 2003

MICHAEL HORABIK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

